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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,584	07/31/2001	Jin-Shan Wang	82817HEC	1795

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/918,584

Applicant(s)

WANG ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 11.

Claim(s) rejected: 1, 10 and 12-18.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' arguments filed 3/5/04 have been fully considered but they are not persuasive.

Specifically, applicants argue that Sacripante et al. (U.S. 6,025,412) is not a relevant reference against the present claims given that Sacripante et al. is directed to an ink jet ink including particles of a dye-polymer resin dispersed in a liquid vehicle and given that combining Figuly (U.S. 5,136,014) with Sacripante et al. would result in the formation of particles of the dye-polymer resin wherein the resin is a hyperbranched polymer while the present invention does not include particles.

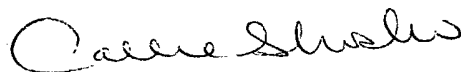
However, it is noted that the present claims only require hyperbranched polymeric dye comprising hyperbranched polymer having dye chromophore incorporated into the polymer backbone. There is nothing in the present claims that excludes the hyperbranched polymeric dye from being in the form of particles. That is, the present claims are open to all hyperbranched polymeric dyes including those in the form of particles.

Applicants argue that the claimed invention does not include particles. As evidence to support this position, applicants (i) point to page 2, lines 19-20 of the present specification which states that traditional dye-based inks do not contain particles observable under a microscope and argue that their dye is traditional in that it does not include particles and (ii) note that there is no disclosure in the present specification regarding particle size.

However, firstly, as noted above, the fact remains that there is nothing in the present claims that excludes the use of hyperbranched polymeric dye in the form of particles. Secondly, the disclosure on page 2, lines 19-20 of the present specification refers to traditional dye based

inks only. There is nothing that states that the presently claimed ink is one of these traditional dye-based inks or that the presently claimed ink does not contain particles observable under a microscope. Further, there is no disclosure that these traditional dye based inks include inks comprising hyperbranched polymeric dyes as required in the present claims. Additionally, while it is agreed that there is no disclosure in the present specification regarding particle size, absence of a positive limitation regarding particle size does not support the exclusion of hyperbranched polymeric dyes in the form of particles from the present claims.

Applicants argue that the combination of Sacripante et al. with Figuly would not be desirable in the claimed invention because particles do not allow reliable firing of the ink jet ink composition. However, applicants have offered no clear and convincing evidence to support this position. Applicants do point to page 2, lines 27-29 of the present specification which discloses that pigment inks have a tendency to clog orifices of the printhead resulting in deterioration of print quality as support for their position that particles do not allow reliable firing of the ink jet ink composition. However, such disclosure is not persuasive in overcoming the "closest" prior art given that Sacripante et al. and Figuly are not drawn to the use of pigments but rather hyperbranched polymeric dye. Further, it is significant to note that there is no requirement in the present claims regarding firability or nozzle clogging and nothing that excludes the hyperbranched polymeric dye from being in the form of particles.



Callie E. Shosho
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Art Unit 1714